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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,577	12/05/2003	Scott A. Burton	57260US003	8901
32692 7590 06/18/2007 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER FUBARA, BLESSING M	
			ART UNIT 1618	PAPER NUMBER
			NOTIFICATION DATE 06/18/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

Office Action Summary

Application No.

10/728,577

Applicant(s)

BURTON ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/01/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 27-53, 56-59 and 61-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 54, 55, 60 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/5/07 & 5/14/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of response to restriction/election requirement and remarks filed 03/01/07; IDS filed 5/5/2007 and 5/14/2007.

1. Applicant's election with traverse of Group I, claims 1-26, 54, 55, 60 and 71 in the reply filed on 03/01/07 is acknowledged. The traversal is on the ground(s) that the search would not place undue burden on the examiner and that restriction between the four groups would require substantial duplication on the part of the USPTO. This is not found persuasive because as applicant concedes, additional consideration would be needed and the product of Group I can be made by materially different process and each of the groups can support different patents within the art. Claims 27-53, 56-59, 61-70, 72 and 73 are withdrawn from examination.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-17, 20-23, 54, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzi et al. (US 6,217,889).

Lorenzi discloses compositions comprising synthetic polymer such as polyamides, polyurethane foam and polyesters (column 4, lines 49-64), which is constituent of the creped non-woven layer of the composition in the form of film of sponges (column 4, lines 12,13; column 6, lines 48-51; column 8, lines 37-40) and meeting claims 1, 2, 7-12, 16, 20, 21, 54; therapeutic agents such as silver nitrate antiviral agents (column 31, line 64) or zinc oxide sunscreen actives (column 32, lines 28 and 29) meeting claim 1; composition may also contain cationic lathering surfactants (column 14, lines 32-46) meeting claims 13 and 14; the composition may also contain dyes or preservatives (Example 8) and silicone antifoaming agent (column 24, line 1) meet the requirements of claim 15. The emulsion of Lorenzi is an inverse emulsion (column 23, lines 45 and 46). Combinations of polymers are contemplated (column 4, lines 54) meet claim 17. Lorenzi suggests that polymeric gelling agents in the form of particles can be used (column 35, lines 21-23 and 28) meeting the particle requirement of claim 1. Claim 55 is the intended use of the composition so that Lorenzi meets the claim. Regarding the microparticles, it is noted that there is no demonstration in applicant's specification that the particle size of 10 microns provides unexpected results. The solubility parameter recited in claim 1 for the silver compound is inherent to the silver compound because a compound and its properties are not separable. Therefore, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to prepare and use the formulation of Lorenzi with suggestion in Lorenzi to use particles of gelling agents. In the absence of factual showing, the particle size recited in claim 1 does not patentably distinguish the claimed invention over Lorenzi.

5. Claims 1-26, 54, 55, 60 and 71 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Asmus (US 5,270,358).

Asmus discloses a composite (column 40, lines 16-45) as a wound care product (column 44, lines 17-30) meeting claims 60 and 71; the composite contains a gel at 1-95 wt % and having a size of 1-600 microns (column 19, lines 16-20) with the particle size encompassing the claimed particle size of 10 micron or less in claims 1-5; the composite also contains hydrocolloid (column 6, line 54 to column 8, line 50) meeting limitation of a hydrophilic polymer and a swelling agent; the composite composition contains antimicrobial agents such as silver oxide (column 12, lines 27-44) meeting the requirement for bioactive agent of claim 1; the pressure sensitive adhesive (column 4, lines 53 to column 6, line 29) meeting the limitation of matrix polymer of claim 1; the presence of water (column 9, lines 66-67) meets claim 26; tackifiers and crosslinkers and stabilizers (column 6, lines 3) meet claim 15. Claim 54 is an article of the composition and medical article recited in the preamble is the intended use of the composition so that Asmus meets claim 54. Claim 54 is met because the claim is an intended use of the composition. The solubility parameter recited in claim 1 for the silver compound is inherent to the silver compound because a compound and its properties are not separable. Claim 1 is a product by process claim and patentability of the claim is based on the product and not on the

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manipulations of the process steps. In the alternate, the particle size of Asmus renders obvious the recited particle size since the disclosed particle size overlaps the recited particle size.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-26, 54, 55, 60 and 71 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10, 12-51, 53-55, 58-93; 1-34, 1-44 of copending Application Nos. 10/728,439; 10/387,236; 10/728,446. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims and the co-pending claims are directed to composition that contain bioactive silver compounds, polymer matrix, foaming agent and the composition is used as care for wounds.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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8. Claims 1-26, 54, 55, 60 and 71 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/729,114 in view of Asmus (5,270,358). The copending application discloses the composition of the examined claims except that the claims are silent as to whether the composition is an emulsion or not. However, Asmus discloses an emulsion that comprises the composition of the copending application for use in wound care. Therefore, it would have been obvious to use the composition of the co-pending application as an emulsion in wound treatment.

This is a provisional obviousness-type double patenting rejection.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Blessing Fubara
Patent Examiner
Tech. Center 1600

A handwritten signature in black ink, appearing to read 'B. Fubara', is written over the printed name 'Blessing Fubara'.